



Paper No. 4

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OFFICE OF PETITIONS

ON PETITION

The petition is dismissed as moot, since the patent issued before treatment of the petition by an appropriately empowered USPTO official.

## BACKGROUND

- 1.) A Notice of Allowance and Issue Fee Due was mailed October 19, 2001, which required payment of the issue fee on or before January 22, 2002.
- 2.) The issue fee was paid December 26, 2001.
- 3.) On January 30, 2002, applicant filed a petition under 37 CFR 1.313(c)(1) for withdrawal from issue. The petition included an admission, per the rule, that at least one claim was unpatentable over a Japanese patent document supplied in an accompanying IDS, as well as an amendment to the claims that was asserted to distinguish the claims over the new reference, and a check for the associated fees. The petition was filed in the Office of Petitions, and included a request for prompt processing in light of the then projected issue date of February 5, 2002.
- 4.) The patent issued February 5, 2002, with the petition undecided.

## DISCUSSION

Once an applicant pays the issue fee in reply to a Notice of Allowance, the USPTO has little discretion but to issue the patent. See 35 U.S.C. § 151, ¶ 2 (upon payment of the

issue fee, "the patent shall issue"); Harley v. Lehman, 981 F. Supp. 9, 11-12, 44 USPQ2d 1699, 1701-02 (D.D.C. 1997). As inspection of the record fails to reveal that any timely action was taken under 37 CFR 1.313 to prevent issuance by an appropriately empowered USPTO official **prior** to publication, the patent clearly issued to the above-identified application on February 5, 2002. See Blacklight Power, Inc. v. Dickinson, 2000 U.S. Dist LEXIS 11754, 55 USPQ2d 1812 (D.D.C. 2000).

Unfortunately, while the petition was appropriately sent directly to the Office of Petitions, pursuant to MPEP 1308, with sufficient time to effectuate withdrawal if the petition had been diligently treated, through an inadvertent clerical error, the petition was overlooked by this office and the patent duly issued. The Office of Petitions regrets this oversight and sincerely apologizes for any inconvenience this may have caused applicant. Nevertheless, the inadvertence of the USPTO in this matter has caused or contributed to an extraordinary circumstance beyond the control of applicant, wherein further relief may be forthcoming.

None of the authorized fees have been charged, or the check processed. Check No. 1399, in the amount of \$310, is being returned with this decision.

This patented file is being forwarded to the Special Programs Law Office for further consideration of this matter.

Telephone inquiries concerning this matter may be directed to the undersigned at telephone number (703) 305-1820.



Brian Hearn  
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Office of Petitions  
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for Patent Examination Policy

Enclosure: Check No. 1399